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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,688	08/31/2001	Richard A. Burgin	10017723-1	2115

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

LAZARO, DAVID R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/944,688	Applicant(s) BURGIN ET AL.	
	Examiner David Lazaro	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 are pending in this Office Action.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In the last line, "such images" should be changed. The use of "the" or "said" would be preferable to using "such" to rule out any possible indefiniteness. "images" should be "selected images" for consistency. Appropriate correction is required.

3. Claims 7 and 13 are objected to because of the following informalities: In regards to instances of "such images", the use of "the" or "said" would be preferable to using "such" to rule out any possible indefiniteness. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-9 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,324,545 by Morag (Morag).

6. With respect to Claim 1, Morag teaches a method for facilitating the ease of handling and exchange of digital images, the method comprising: obtaining a set of multiple digital images (Col. 5 lines 46-59); facilitating selection of images from the set (Col. 6 lines 5-15); collecting the selected images into a self-contained album (Col. Lines 24-44), wherein the album comprises the selected images (Col. 6 lines 24-35) and computer executable instructions for viewing such images (Col. 6 lines 35-41).
7. With respect to Claim 2, Morag teaches all the limitations of Claim 1 and further teaches transmitting the album over a communications network (Col. 6 lines 33-44).
8. With respect to Claim 3, Morag teaches all the limitations of Claim 1 and further teaches attaching the album to an email message (Col. 6 lines 35-41); transmitting the email message over a communications network (Col. 6 lines 35-41).
9. With respect to Claim 5, Morag teaches all the limitations of Claim 1 and further teaches the computer executable instructions of the album are capable of facilitating viewing of images having only one format (The examiner interprets the computer executable instructions of Morag, Col. 6 lines 33-41, as capable of facilitating viewing of images in any format available through the different acquiring devices cited by Morag, Col. 5 lines 46-49, which would inherently have different formats dependent on manufacturer. Thus the instructions would be capable of facilitating viewing of either an album of images of only one format or an album of images having multiple formats)
10. With respect to Claim 6, Morag teaches all the limitations of Claim 1 and further teaches the computer executable instructions of the album are capable of facilitating viewing of images having multiple formats (The examiner interprets the computer

executable instructions of Morag, Col. 6 lines 33-41, as capable of facilitating viewing of images in any format available through the different acquiring devices cited by Morag, Col. 5 lines 46-49, which would inherently have different formats dependent on manufacturer. Thus the instructions would be capable of facilitating viewing of either an album of images of only one format or an album of images having multiple formats).

11. With respect to Claim 7, Morag teaches a method for generating a self-contained album of digital images, the method comprising: inserting images into an album (Col. 6 lines 5-15 and 24-31); inserting computer executable instructions for viewing such images into the album (Col. 6 lines 33-41).

12. With respect to Claim 8, Morag teaches all the limitations of Claim 1 and further teaches transmitting the album over a communications network (Col. 6 lines 33-44).

13. With respect to Claim 9, Morag teaches all the limitations of Claim 1 and further teaches attaching the album to an email message (Col. 6 lines 35-41); transmitting the email message over a communications network (Col. 6 lines 35-41).

14. With respect to Claim 11, Morag teaches all the limitations of Claim 1 and further teaches the computer executable instructions of the album are capable of facilitating viewing of images having only one format (The examiner interprets the computer executable instructions of Morag, Col. 6 lines 33-41, as capable of facilitating viewing of images in any format available through the different acquiring devices cited by Morag, Col. 5 lines 46-49, which would inherently have different formats dependent on manufacturer. Thus the instructions would be capable of facilitating viewing of either an album of images of only one format or an album of images having multiple formats)

15. With respect to Claim 12, Morag teaches all the limitations of Claim 1 and further teaches the computer executable instructions of the album are capable of facilitating viewing of images having multiple formats (The examiner interprets the computer executable instructions of Morag, Col. 6 lines 33-41, as capable of facilitating viewing of images in any format available through the different acquiring devices cited by Morag, Col. 5 lines 46-49, which would inherently have different formats dependent on manufacturer. Thus the instructions would be capable of facilitating viewing of either an album of images of only one format or an album of images having multiple formats).

16. With respect to Claim 13, Morag teaches a computer-readable medium having computer-executable instructions that, when executed by a computer, performs a method for facilitating the ease of handling and exchange of digital images, the method comprising: collecting images into a self-contained album (Col. 6 lines 5-15 and 24-31); inserting computer executable instructions for viewing such images (Col. 6 lines 33-41).

17. With respect to Claim 14, Morag teaches all the limitations of Claim 1 and further teaches transmitting the album over a communications network (Col. 6 lines 33-44).

18. With respect to Claim 15, Morag teaches all the limitations of Claim 1 and further teaches attaching the album to an email message (Col. 6 lines 35-41); transmitting the email message over a communications network (Col. 6 lines 35-41).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 4, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morag in view of U.S. Patent 6,035,323 by Narayen et al. (Narayen).

21. With respect to Claim 4, Morag teaches all the limitations of Claim 1 and further teaches any image processing technique can be applied to the images (Col. 12 lines 1-11). Morag does not explicitly disclose converting the selected images into a common format. Narayen teaches converting selected images of an album into a common format (Col. 8 lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method taught by Morag and modify it as indicated by Narayen such that the method further comprises converting the selected images into a common format. One would be motivated to have this as there is need for easily distributing or publishing images over a network, such as the internet (Col. 2 lines 27-31 and Col. 8 lines 38-45 of Narayen).

22. With respect to Claim 10, Morag teaches all the limitations of Claim 7 and further teaches any image processing technique can be applied to the images (Col. 12 lines 1-11). Morag does not explicitly disclose converting the images into a common format. Narayen teaches converting selected images of an album into a common format (Col. 8 lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method taught by Morag and modify it as indicated by Narayen such that the method further comprises converting the images into a common format. One would be motivated to have this as there is need for easily distributing or

Art Unit: 2155

publishing images over a network, such as the internet (Col. 2 lines 27-31 and Col. 8 lines 38-45 of Narayen).

23. With respect to Claim 16, Morag teaches all the limitations of Claim 13 and further teaches any image processing technique can be applied to the images (Col. 12 lines 1-11). Morag does not explicitly disclose converting the images into a common format. Narayen teaches converting selected images of an album into a common format (Col. 8 lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method taught by Morag and modify it as indicated by Narayen such that the method further comprises converting the images into a common format. One would be motivated to have this as there is need for easily distributing or publishing images over a network, such as the internet (Col. 2 lines 27-31 and Col. 8 lines 38-45 of Narayen).

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. "The World's First Email-Sized Photo Album" from Digital Photography News at www.dphoto1.com. 04/25/04. Discloses the announcement of AvailaSoft *Photo2Album* software which can create a self-contained photo album such that it can be emailed and viewed by the recipient without *Photo2Album* or any other pre-installed software.

Art Unit: 2155

26. "100 Photos, Compressed in a svelte E-Mail album" New York Times, 3/25/2004, Vol. 153, Issue 52799, pG3. Another announcement of the AvailaSoft *Photo2Album* software. Abstract only.

27. "Technical Information Bulletin: Comparison of KODAK Picture CD and KODAK PHOTO CD Discs" from www.kodak.com June 1999. Demonstrates the ability to include viewing software with a set of photos. Software includes email capability.

28. U.S. Patent 5,760,917 by Sheridan "Image Distribution Method and System" June 2, 1998. Discloses a system for access rights for distribution (including emailing) of image sets.

29. U.S. Patent 6,014,688 by Venkatraman et al. "E-Mail program capable of transmitting, opening and presenting a container having digital content using embedded executable software." January 11, 2000. Discloses an enhanced email message capable of sending content, such as images, to a recipient. The message includes embedded software that ensures the recipient will be able to view the contents.

30. U.S. Patent 6,567,983 by Shiimori "Electronic album producing and viewing system and method" May 20, 2003. Discloses creation of an album by a client that is capable of being view by others through network communications with an image server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro
December 14, 2004



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SUPERVISORY PATENT EXAMINER